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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/771,865	01/29/2001	Michael Waters	70702	7798

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CHICAGO, IL 60603-3406

EXAMINER

MOONEYHAM, JANICE A

ART UNIT	PAPER NUMBER
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3629

DATE MAILED: 11/04/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/771,865

Applicant(s)

WATERS, MICHAEL

Examiner

Jan Mooneyham

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 29 July 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-12 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No: \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date: _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date: _____  | 6) <input type="checkbox"/> Other: _____                                    |

**DETAILED ACTION**

1. This is in response to the applicant's communication filed on July 29, 2004, wherein:  
  
Claims 1-12 are currently pending;  
  
Claim 12 is added;  
  
Claims 1-5, 9, and 11 are amended;  
  
No claims have been cancelled.

***Response to Amendment***

***Claim Rejections - 35 USC § 112***

2. The applicant has amended claim language to overcome the rejections under the second paragraph of 35 U.S.C. 112: This rejection is hereby withdrawn.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 1-12 are rejected under 35 U.S.C. 102(e) as being anticipated by Hunter et al (US Patent 6,298,327) (hereinafter referred to as Hunter)

Hunter discloses a system for developing commercially valuable intellectual property rights, the system comprising:

A communication path for accessible from a plurality of locations (Fig. 1 (15)).

A first database accessible by multiple parties (Fig. 1 and Fig. 2)

A second database accessible by multiple parties.

The fact that the communication path is for allowing independent sources to send information is the intended use of the system and the system in Hunter is capable of performing these functions.

The fact that the first database is an idea database constructed from information packets, that the structured database is proprietary technology based on commercially valuable forms of the information packets, or that the database is accessible to potential purchasers of rights is nonfunctional descriptive data that is stored in the database. The data is not functionally related to the structure and thus is given little patentable weight. Thus, this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, see *In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994).

Therefore it would have been obvious to a person of ordinary skill in the art at the time the invention was made to store any data in the databases because such data does not functionally relate to the structure of the system and merely labeling the data differently from that in the prior art would have been obvious.

As for Claim 2 and 6:

The Examiner takes Official Notice that web pages are old and well known in any system that operates over a network. Examples are the PTO websites. Preapproved access is also old and well known since access is only granted to parties that need access to the information while excluding parties that do not need to have access to the information. Examples of preapproved

access is the ability to logon to certain websites here at the PTO. It is also old and well known to have communication paths established over an internet of linked computers since often many different entities are involved in the process and the parties from the entity need access to the information and need to be able to communicate with each other.

As for Claim 3:

The Examiner takes Official Notice that WAN and Intranet systems are old and well known in systems that allow inter communication between parties within a company (Intranet) and parties outside the company. An example of this is the PTO website which has the Intranet for PTO employees to access and the Internet.

As for Claim 4:

Hunter discloses a system wherein the received information includes innovations (col. 2, lines 43-50). Furthermore, the type information received is considered to be nonfunctional descriptive data and is given little patentable weight since the type data is not functionally related to the structure of the system.

As for Claim 5:

The Examiner takes Official Notice that it is old and well known to have the communication path electronically encrypted to prevent hackers.

As for Claim 7:

Hunter discloses a system wherein one of the experts is legal (col. 2, lines 43-50).

Once again, because this is a system claim, the type fields and the type of data (issued patents) is considered to be nonfunctional descriptive data and given little patentable weight.

As for Claim 8:

It takes Official Notice that it is old and well have restricted access protocols to allow for preapproved entities to purchase or license desired patents. Examples of preapproval are buying a home, a car or various other credit. The reason for the restricted access is nonfunctional descriptive data and given little patentable weight.

As for Claim 9:

Hunter a screening board (Fig. 3 – Experts, patentability assessment, marketability assessment – an assessment is a screening)

In a system claim, the fact that the expert review board includes screening board is nonfunctional descriptive data and given little patentable weight.

As for Claim 10:

Hunter discloses a system wherein the predetermined factors include markets, status of competitive activity and patentability. (Fig. 3 Marketability and Patentability).

The predetermined factors are nonfunctional descriptive data and given little patentable weight.

As for Claim 11:

Hunter discloses a second communication path and a second database (Figs. 2 and 3).

As for Claim 12:

The fact that the structured database includes the information packets selected by the host is nonfunctional descriptive data and given little patentable weight.

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***Response to Arguments***

4. Applicant's arguments filed June 24, 2004 have been fully considered but they are not persuasive.

The applicant's invention is a system, not a method.

MPEP Section 2106 states that:

The subject matter of a properly construed claim is defined by the terms that limit its scope. It is this subject matter that must be examined. As a general matter, the grammar and intended meaning of terms used in a claim will dictate whether the language limits the claim scope. Language that suggests or makes optional but does not require steps to be performed or does not limit a claim to a particular structure does not limit the scope of a claim or claim limitation. The following are examples of language that may raise a question as to the limiting effect of the language in a claim:

- (A) statements of intended use or field of use,
  - (B) "adapted to" or "adapted for" clauses,
  - (C) "wherein" clauses, or
  - (D) "whereby" clauses.
- This list of examples is not intended to be exhaustive.

MPEP section 2106 VI states:

**VI. DETERMINE WHETHER THE CLAIMED INVENTION COMPLIES WITH 35 U.S.C. 102 AND 103**

As is the case for inventions in any field of technology, assessment of a claimed computer-related invention for compliance with 35 U.S.C. 102 and 103 begins with a comparison of the claimed subject matter to what is known in the prior art. If no differences are found between the claimed invention and the prior art, the claimed invention lacks novelty and is to be rejected by Office personnel under 35 U.S.C. 102. Once distinctions are identified between the claimed invention and the prior art, those distinctions must be assessed and resolved in light of the knowledge possessed by a person of ordinary skill in the art. Against this backdrop, one must determine whether the invention would have been obvious at the time the invention was made. If not, the claimed invention satisfies 35 U.S.C. 103. Factors and considerations dictated by law governing 35 U.S.C. 103 apply without modification to computer-related inventions. Moreover, merely using a computer to automate a known process does not by itself impart nonobviousness to the invention. See *Dann v. Johnston*, 425 U.S. 219, 227-30, 189 USPQ 257, 261 (1976); *In re Venner*, 262 F.2d 91, 95, 120 USPQ 193, 194 (CCPA 1958).

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If the difference between the prior art and the claimed invention is limited to descriptive material stored on or employed by a machine, Office personnel must determine whether the descriptive material is functional descriptive material or nonfunctional descriptive material, as described supra in paragraphs IV.B.1(a) and IV. B.1(b). Functional descriptive material is a limitation in the claim and must be considered and addressed in assessing patentability under 35 U.S.C. 103. Thus, a rejection of the claim as a whole under 35 U.S.C. 103 is inappropriate unless the functional descriptive material would have been suggested by the prior art. In re Dembiczak, 175 F.3d 994, 1000, 50 USPQ2d 1614, 1618 (Fed. Cir. 1999). Nonfunctional descriptive material cannot render nonobvious an invention that would have otherwise been obvious. > In re Ngai, \_\_\_ F.3d \_\_\_, 2004 WL 1068957 (Fed. Cir. May 13, 2004).< Cf. In re Gulack, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983) (when descriptive material is not functionally related to the substrate, the descriptive material will not distinguish the invention from the prior art in terms of patentability).

Common situations involving nonfunctional descriptive material are:

- a computer-readable storage medium that differs from the prior art solely with respect to nonfunctional descriptive material, such as music or a literary work, encoded on the medium,
- a computer that differs from the prior art solely with respect to nonfunctional descriptive material that cannot alter how the machine functions (i.e., the descriptive material does not reconfigure the computer), or
- a process that differs from the prior art only with respect to nonfunctional descriptive material that cannot alter how the process steps are to be performed to achieve the utility of the invention.

The applicant's argument that in Claim 1 the communication path allows independent sources that includes individuals or organizations to send information and that the Hunter reference does not disclose this has been explained above. The fact that the path allows independent sources to send information is nonfunctional descriptive material as discussed above and intended use. In a system claim, the fact that the database is accessible and capable of sending information is all that is needed. The fact that the database is an ideas database or who is able to access it is nonfunctional descriptive data.



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The fact that the information in the idea database is constructed from information packets selected by a host is nonfunctional data in a system claim since the data does not functionally relate to the system.

This is also true of the fact that the structured database comprises proprietary technology.

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, although Risen was only used in the first Office Action, the Examiner's motivation to combine was found in the Risen reference (column 1, lines 16-25).

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

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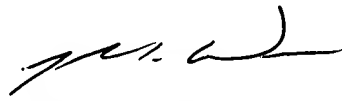
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jan Mooneyham whose telephone number is (703) 305-8554.

The examiner can normally be reached on Monday through Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on (703) 308-2702. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

JM



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